

02-12-07 12:00

From-KATTEN MUCHIN ROSENMAN 13129021061

3129021061

T-406 P.01 F-197

RECEIVED  
CENTRAL FAX CENTER

FEB 12 2007

**Katten**

Katten Muchin Rosenman LLP

525 W Monroe Street  
Chicago, IL 60661-3693  
312.902.5200 tel  
312.902.1061 fax**Facsimile**

To	Company	Fax Number	Phone Number
Examiner Traci Smith	USPTO - Art Unit 3629	571-273-8300	
Date	Client/Matter Number		
February 12, 2007	331235-00021		
From	Attorney Number		
John S. Paniaguas	32347		
Phone	Fax		
312.902.5312	312.577.4532		

Total number of pages, including cover letter: 20  
If you do not receive all of the pages, please call: 312.902.5200

Comments Serial No. 696,894; Filed: October 30, 2003

**Certificate of Transmission**

I hereby certify that this correspondence is being transmitted via facsimile to the U.S. Patent & Trademark Office to (571) 273-8300 on this 12th day of February, 2007.

Mary Kay Darr  
Typed or printed name

Mary Kay Darr  
Signature

**For Messenger Department Use Only**

Your fax has been sent. Attached is your original.

Date Time

Signature

**Important**

This facsimile transmission contains information intended for the exclusive use of the individual or entity to whom it is addressed and may contain information that is proprietary, privileged, confidential and/or exempt from disclosure under applicable law.

If you are not the intended recipient (or an employee or agent responsible for delivering this facsimile transmission to the intended recipient), you are hereby notified that any copying, disclosure or distribution of this information may be subject to legal restriction or sanction. Please notify the sender by telephone to arrange for the return or destruction of the information and all copies.

CHICAGO CHARLOTTE IRVING LONDON LOS ANGELES NEW YORK PALO ALTO WASHINGTON, DC [WWW.KATTENLAW.COM](http://WWW.KATTENLAW.COM)  
LONDON AFFILIATE: KATTEN MUCHIN ROSENMAN CORNISH LLP

A limited liability partnership including professional corporations

RECEIVED  
CENTRAL FAX CENTER

02-12-07 12:00 From-KATTEN MUCHIN ROSENMAN 13129021061

3129021061 T-406 P.02 F-187

FEB 12 2007

PTO/SB/21 (09-08)

Approved for use through 03/31/2007. OMB 0651-0031  
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL  
FORM

(to be used for all correspondence after initial filing)

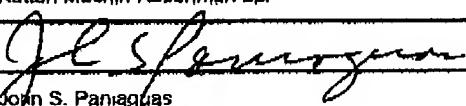
Total Number of Pages in This Submission

Application Number	10/696,894
Filing Date	October 30, 2003
First Named Inventor	Gary W. Ramsden
Art Unit	3629
Examiner Name	Traci L. Smith
Attorney Docket Number	331235-00021

ENCLOSURES (Check all that apply)

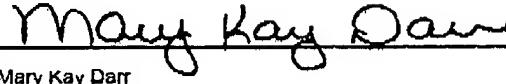
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD. Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brif, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below). Response to Notice of Non-Compliant Appeal Brief
<input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Remarks
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Information Disclosure Statement	
<input type="checkbox"/> Certified Copy of Priority Document(s)		
<input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Katten Muchin Rosenman LLP		
Signature			
Printed name	John S. Paniagua		
Date	February 12, 2007	Reg. No.	31,051

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P O Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature	
Typed or printed name	Mary Kay Darr
	Date
	February 12, 2007

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

RECEIVED  
CENTRAL FAX CENTER

02-12-07 12:00 From-KATTEN MUCHIN ROSENMAN 13129021061

3129021061 FEB 12 2007 10:08 P.03/20 F-197

Approved for use through 01/31/2007. OMB 0651-0032

U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Effective on 12/08/2004

Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818)

**FEE TRANSMITTAL  
For FY 2006** Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$)

## Complete if Known

Application Number	10/696,894
Filing Date	October 30, 2003
First Named Inventor	Gary W. Ramsden
Examiner Name	Traci L. Smith
Art Unit	3629
Attorney Docket No	331235-00021

**METHOD OF PAYMENT** (check all that apply)

Check  Credit Card  Money Order  None  Other (please identify): \_\_\_\_\_

Deposit Account Deposit Account Number: 50-1214 Deposit Account Name: Katten Muchin Rosenman LLP

For the above-identified deposit account, the Director is hereby authorized to (check all that apply)

Charge fee(s) indicated below  Charge fee(s) indicated below, except for the filing fee

Charge any additional fee(s) or underpayments of fee(s)  Credit any overpayments

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES	
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)
Utility	300	150	500	250	200	100
Design	200	100	100	50	130	65
Plant	200	100	300	150	160	80
Reissue	300	150	500	250	600	300
Provisional	200	100	0	0	0	0

**2. EXCESS CLAIM FEES****Fee Description**

Each claim over 20 (including Reissues)

**Small Entity**

Fee (\$): 50 25

Each independent claim over 3 (including Reissues)

Fee (\$): 200 100

Multiple dependent claims

Fee (\$): 360 180

**Total Claims**

<u>Total Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>
- 20 or HP =	<u>                  </u> x <u>                  </u> = <u>                  </u>		

HP = highest number of total claims paid for, if greater than 20.

**Multiple Dependent Claims**

<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>
<u>                  </u>	<u>                  </u>

<u>Indep. Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>
- 3 or HP =	<u>                  </u> x <u>                  </u> = <u>                  </u>		

HP = highest number of independent claims paid for, if greater than 3.

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

<u>Total Sheets</u>	<u>Extra Sheets</u>	<u>Number of each additional 50 or fraction thereof</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>
- 100 =	<u>                  </u>	<u>                  </u> / 50 = <u>                  </u> (round up to a whole number) x <u>                  </u> = <u>                  </u>		

**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Response to Notice of Non-Compliant Appeal Brief/Appeal Brief

**SUBMITTED BY**

Signature

Registration No.  
(Attorney/Agent) 31,051

Telephone 312-902-5200

Name (Print/Type) John S. Paniaguas

Date February 12, 2007

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2

RECEIVED  
CENTRAL FAX CENTER

FEB 12 2007

PATENT  
ATTORNEY DOCKET NO. 331235-00021IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Gary W. Ramsden

CERTIFICATION OF TRANSMISSION

Serial No.: 10/696,894

I hereby certify that this correspondence is being facsimile transmitted ((571) 273-8300) to the United States Patent and Trademark Office on

Filed: October 30, 2003

2/12/07

Title: Automated Package Shipping

Date

Group Art Unit: 3629

Mary Kay Dan  
Signature

Examiner: Traci L. Smith

Mary Kay Dan  
Printed Name of Person Signing  
Certificate

Customer No.: 27160

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF

Sir:

In response to the Notice of Non-Compliant Appeal Brief, mailed on January 22, 2007, please enter the enclosed Appeal Brief which has been revised to overcome the objections in the Notice.

Respectfully submitted,

KATTEN MUCHIN ROSENMAN LLP

By: John S. Paniagua  
John S. Paniagua  
Registration No. 31,051KATTEN MUCHIN ROSENMAN LLP  
1025 Thomas Jefferson Street, N.W.  
East Lobby, Suite 700  
Washington, DC 20007-5201  
Tel: (312) 902-5200  
Fax: (312) 902-1061

02-12-07 12:01

From-KATTEN MUCHIN ROSENMAN 13129021061

3129021061

T-406 P.05/20 F-197

Attorney Docket No. 331235-00021

RECEIVED

CENTRAL FAX CENTER

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

FEB 12 2007

Applicant(s): Gary W. Ramsden )  
Serial No.: 10/696,894 )  
Filed: October 30, 2003 )  
Title: Automated Package Shipping )  
Machine )  
Group Art Unit: 3629 )  
Examiner: Traci L. Smith )  
Confirmation No.: 9250 )

**Applicant's Brief On Appeal**

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Table of Contents**

Real Party in Interest.....	1
Related Appeals and Interferences .....	1
Status of Claims .....	2
Status of Amendments .....	2
Summary of the Claimed Subject Matter.....	2-5
Grounds of Rejection to be Reviewed on Appeal.....	5
Argument .....	5-11
Conclusion .....	11
Appendix A (Claims).....	12
Appendix B (Evidence).....	13
Appendix C (Related Proceedings).....	14

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant(s): Gary W. Ramsden. )  
Serial No.: 10/696,894 )  
Filed: October 30, 2003 )  
Title: Automated Package Shipping Machine )  
Group Art Unit: 3629 )  
Examiner: Traci L. Smith )  
Confirmation No.: 9250 )

**RECEIVED**  
**CENTRAL FAX CENTER**  
**FEB 12 2007**

**Applicant's Brief On Appeal**

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Real Party In Interest**

The real party in interest is Uship Intellectual Properties, LLC, by virtue of an Assignment from the inventors, Gary W. Ramsden and Kenneth W. Liles to Uship Inc., recorded on Reel/Frame 011735/0586 and from Uship Inc., to United Shipping & Technology, Inc., recorded on Reel/Frame 011738/0014 and from United Shipping & Technology, Inc. to The Intelligent Kiosk Company, recorded on Reel/Frame 012653/0454 and 014822/0782 and from The Intelligent Kiosk Company to Uship Intellectual Properties LLC, recorded on Reel/Frame 015687/0045.

**Related Appeals and Interferences**

There are no other appeals or interferences known to the Appellant or the Appellant's representative, which are believed to directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

### Status Of Claims

Claims 77, 79 and 80 are pending. Claims 76 and 78 have been cancelled. Claims 77, 79 and 80 stand rejected. The final rejection of these claims 77, 79 and 80 form the basis for this appeal. In particular, claims 77 and 80 stand rejected under 35 U.S.C. §103 (a) as being unpatentable over Hsieh US Patent No. 4,923,022 ("the Hsieh patent") and Pusic US Patent No. 5,065,000 ("the Pusic patent")<sup>1</sup>. Claim 79 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the Hsieh and Pusic patents further in view of Tateno US Patent No. 4,836,352 ("the Tateno patent"). A Pre-Appeal Brief Request for Review was filed on March 10, 2006. A Notice of Panel Decision<sup>2</sup> was issued on April 27, 2006 advising the Applicant to proceed with an Appeal. In response to a Notice of Non-Compliant Amendment, mailed on October 31, 2006, an Amendment to the claims was filed on November 14, 2006. Appendix A reflects that amendment.

### Status Of Amendments

An amendment pursuant to 37 CFR § 41.33 (a) was filed on May 30, 2006 to simplify the issues on appeal. It appears that this amendment has been entered<sup>3</sup>. The claims as currently amended including the aforementioned amendment are included in Appendix A.

### Summary Of Claimed Subject Matter

The present invention relates to an automated shipping machine, for example, as shown below. The automated shipping machine includes means for receiving payment information from

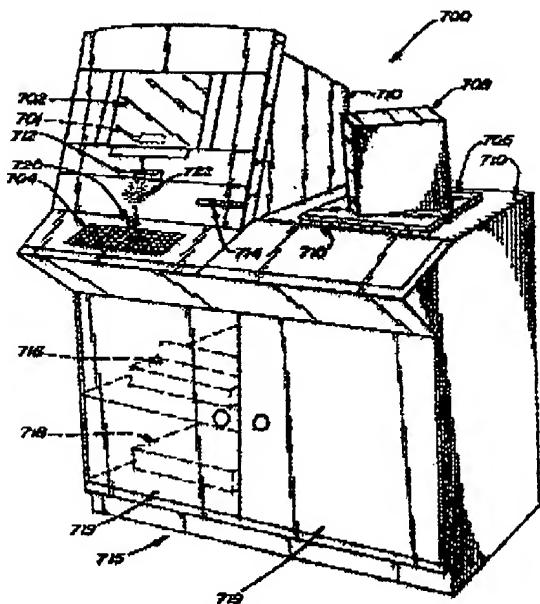
<sup>1</sup> These claims were initially allowed by Examiner Edward Cosimano during a personal interview with Examiner Cosimano attended by the undersigned and the patent owner on August 4, 2005 at substantial expense to the patent owner. The Interview Summary indicates that the claims were allowed and that the application would be allowed pending correction of various informalities. Those informalities were corrected by way of a Communication, mailed on August 16, 2005 and a Petition under 37 CFR § 1.78 (a) (3) to correct the priority claim. The Petition was approved by the Office of Petitions on October 13, 2005. Shortly thereafter, an Office Action was issued on November 2, 2005 by the current Examiner Smith. Upon inquiry, the undersigned was informed that Examiner Cosimano was fired.

<sup>2</sup> The Applicant notes (and was surprised) that the Request for a Pre-Appeal Review was decided by a three person panel that included the current Examiner Smith and the current SPE Weiss.

<sup>3</sup> The Amendment was filed pursuant to 37 CFR §41.33 on May 30, 2006, prior to the filing of the Appeal Brief on June 5, 2006 and is thus covered by 37 CFR §41.33 (a). As set forth in that section, entry of Amendments filed under that section appear are not mandatory ("Amendments filed after the date of filing an appeal pursuant to Sec. 41.31(a)(1) through (a)(3) and prior to the date a brief is filed pursuant to Sec. 41.37 *may be admitted* as provided in Sec. 1 116 of this title."). Notwithstanding, upon examination of the file history on Private PAIR, the applicant notes an entry on a "Patent Application Fee Determination Record" for the May 30, 2006 amendment. Based upon that entry, the Applicant assumes the Amendment was entered.

a customer; a scale for weighing a parcel or envelope to be mailed; and a processing system for receiving various information, as described below, relating to the parcel or envelope to be mailed. In accordance with an important aspect of the invention, as shown below, the claimed invention includes a processor that is configured to compute shipping cost of a parcel or envelope to be mailed as a function of shipping information provided to an input system by the customer information recorded by the machine as well as payment information.

FIG. 20

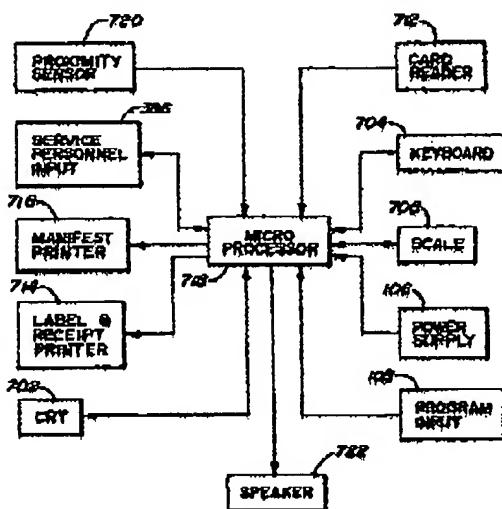


The shipping information provided by the customer may be provided by way of the keyboard 704 or a touch screen display as indicated in paragraph [0093] of the application. This customer supplied information includes at least a destination for the parcel or envelope to be mailed and an indication of a delivery option selected by the customer, selectable from at least two delivery options. The customer supplied information may also include dimensional information, such as the height, length and width of the parcel to be mailed as measured by measuring apparatus available at the automatic shipping machine. The payment information may include a card reader for reading credit card information which is processed by the microprocessor. The machine also includes a scale 706 for measuring the weight of the parcel to

be mailed. The processor computes a cost for mailing the parcel or envelope to the specified destination as a function of the selected delivery option, destination and weight of the parcel to be mailed.

The machine also includes "printer means" for printing a bar code identifying at least destination information for placement on the parcel or envelope to be mailed. The printer means also prints a shipping receipt which indicates at least the cost of delivering the parcel or envelope to the destination via the delivery service chosen by the customer.

FIG. 21



Pursuant to 37 CFR §41.35 (c) (v), the Table below identifies the reference numbers, figures, pages and line numbers for the two claim elements in independent claim 77 in means plus function format.

Reference Character Number	Receiving Means Figure Number(s)	Specification page and line numbers
30	1, 2, 5, 6 and 10	Page 14, line 35-Page 16, line 34
230	7	Page 22, lines 17-19
328	12, 17	Page 35, line 15-Page 36, line 28
712	20, 21	Page 46, lines 22-24

	Printer Means	
26	2, 3, 5, 6 and 10	Page 16, line 32-Page 17, line 15 Page 26, lines 19-23
90	5, 10 and 17	Page 12, lines 23-24 Page 19, lines 4-7
326	17	Page 28, lines 12-15 Page 39, lines 20-22 Page 43, lines 9-13 Page 53, lines 1-15 Page 53, lines 24-34
714	20, 21	Page 46, lines 22-24

Grounds of Rejection to be Reviewed on Appeal

- I. The Examiner's rejection of Claims 77 and 80 under 35 U.S.C. 103(a) as being unpatentable over the Hsieh and Pusic references.
- II. The Examiner's rejection of Claim 79 under 35 U.S.C. 103(a) as being unpatentable over the Hsieh and Pusic references and further in view of the Tateno patent.

Argument

I. The Examiner's rejection of Claims 77 and 80 under 35 U.S.C. 103(a) as being unpatentable over the Hsieh and Pusic references should be reversed.

Claims 77 and 80 have been rejected under 35 U.S.C. 103(a) as being unpatentable over the Hsieh and Pusic references. It is respectfully submitted that the Examiner has failed to set forth a *prima facie* case of obviousness as required by MPEP §2143. It is also respectfully submitted that the rejection is based upon errors of law in contradistinction to case law handed down by the Court of Appeals for the Federal Circuit.

More particularly, § 2143 of the MPEP requires:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference, or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined)

*must teach or suggest all of the claim limitations. The teaching or suggestion to make the claim combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure."*

As will be discussed in detail below, the rejection fails to meet the criteria of MPEP § 2143 for several reasons. First, it is respectfully submitted that the references do not disclose all of the elements recited in the Claims at issue. Second, since all of the elements are not found in the references, there can be no expectation of success. Third, there is no motivation or suggestion to combine the references in the manner suggested by the Examiner.

**THE REFERENCES DO NOT DISCLOSE ALL OF THE ELEMENTS**

It is respectfully submitted that the references do not disclose all of the limitations of the claims. In particular, with respect to Claim 77, the claim recites several elements, identified below as paragraphs (a) and (b), which are clearly not disclosed or suggested by any of the references of record. In particular, it is respectfully submitted that those portions of the claim elements shown in bold are not disclosed by the references.

*(a) <sup>4</sup> a display for displaying at least two selectable delivery options;*

*(b) a processor system, in communication with said input system and said scale, for receiving said information representative of the destination, the selected delivery option and said parcel weight and computing a cost for mailing said package to said destination as a function of said parcel weight and the selected delivery option;*

Element (b) recites a processor system which inherently receives and processes three (3) types of information, as follows.

- Destination of the parcel or envelope
- Indication of the delivery option selected
- The weight of the parcel

In particular, based upon receiving the three types of information, mentioned above, the processor is configured to compute the cost for mailing the parcel or envelope to be mailed as a function of all three variables: weight, destination and selected delivery option. Stated another way, the claimed automated shipping machine can compute the cost of mailing a parcel to

---

<sup>4</sup> The designations (a) and (b) have been added for discussion.

different destinations for each delivery option. Thus, unlike the Hsieh patent, the selectable delivery options are not limited to delivery options whose costs are independent of destination.

None of the references of record teach such a feature. Rather, the references of record either do not disclose such a feature or teach away from it. In particular, the Pusic patent does not disclose an operator selectable delivery option. As such, it is clear that the system disclosed in the Pusic patent does not disclose computation of the mailing cost of a parcel based in part upon a selected delivery option and destination.

The Hsieh patent discloses a plurality of letter sorting keys 22 (Fig. 1). It appears that the Examiner relies on those keys 22 to meet the limitation of a processor that is configured to compute the mailing cost of the parcel based upon the weight of the parcel and the delivery option selected. Indeed, Paragraph 10 d of the Detailed Action cites the Hsieh patent, Col 4, lines 9-11 as disclosing this feature.<sup>5</sup> However, it is clear from the Hsieh patent that the processor is not configured to calculate the mailing cost of different destinations for each selected delivery option. In fact, the system taught by the Hsieh patent does not take into the destination of the parcel ("The postage will thereupon be calculated according to the weight of the letter and the type of mailing service which the operator selects." Hsieh, Col. 4, lines 7-9).

Although the letter sorting keys 22 are not defined anywhere in the specification of the Pusic patent, it is clear that the device taught by the Pusic patent is unable to compute a mailing cost for different destinations for a selected delivery option. As such, it is clear that the only "delivery options" that can be provided by the letter sorting keys 22 are options in which the cost of mailing the parcel is uniform for all destinations for each selected delivery option and thus the cost of mailing the parcel does not depend upon the destination for the selected delivery option. The only hint of the available delivery options possible by the letter sorting keys 22 are "registered" and "international letters", as mentioned in the Hsieh patent. (See Hsieh patent, Col. 1, lines 18-22; "Moreover, most post offices are only open during the day, thus inconveniencing those persons wishing to post *registered* letters or *international* letters etc., at times not coinciding with standard business hours." and Hsieh patent, Col. 1, line 64-Col. 2, line 3; "Therefore, the letters held within said casing of this invention will have already been weighed, stamped and sorted when the postal worker retrieves them, thus saving on the normal

<sup>5</sup> Col. 4, lines 9-11 of the Hsieh patent recite "The postage will be shown on the display screen 19 and the customer is asked to confirm if the letter is to be mailed, . ." It is believed that the Examiner actually meant to cite Col. 4, lines 7-9 which state: " The postage will thereupon be calculated according to the weight of the letter and the type of mailing service which the operator selects."

time required for letter-processing in a post office. In addition, a person can mail *registered* or *international* letters, etc., at any time of day or night, whenever said automatic mailing apparatuses are installed.") It follows *a fortiori* that the cost of these delivery options, i.e. registered and international, at least as of the filing of the Hsieh patent, must not have been dependent upon destination at all. The Board is respectfully requested to take notice of the fact that the delivery options disclosed in the Hsieh patent are thus similar to a US Postal Service First Class delivery option, which is strictly a function of the weight of the parcel and does not depend on destination within the US.

As such, it follows *a fortiori* that the Hsieh patent teaches away from a system in which pricing for all delivery options is not uniform and is dependent of the intended destination of a parcel. Stated another way, the machine recited in the claims at issue is an improvement over the machine taught by the Hsieh patent in that, the claimed invention is not limited to delivery options whose cost is independent of the destination of the parcel. Rather, the claimed machine can be used for all sorts of delivery options including delivery options whose prices vary as a function of the destination for a selected delivery option. Thus, it is respectfully submitted that neither the Hsieh patent nor the Pusic patent discloses a processor, as recited in the claims at issue, configured to receive information regarding the destination of the parcel; the delivery option selected and weight of the parcel and computes the postage of the parcel based upon all three variables.

As such, the machine taught by the Hsieh patent could not be used for selectable delivery options in which the pricing for a delivery option is dependent upon the destination of the parcel. The Board is respectfully requested to take notice of three exemplary Federal Express delivery options; namely: "Priority Overnight"; "Standard Overnight" and "Economy 2 Day". The pricing for each delivery option varies as a function of "Region". The "regions", in turn, are a functions of zip code or destination. Thus, it is clear that the delivery options illustrated in the attachments are clearly dependent upon the intended destination of the parcel.<sup>6</sup>

It should also be clear that neither the Hsieh or Pusic patents, either alone or in combination as suggested by the Examiner, could be used for the aforementioned Federal Express delivery options, since the machines disclosed in those patents either do not allow for

<sup>6</sup> Copies illustrating the described delivery options are attached for the convenience of the Board. These attachments are provided herein for the sole purpose of illustrating delivery options in which the pricing varies as a function of the destination. The exemplary delivery options were obtained on the Internet at <http://iqimaging.com/shipping.htm> and represent pricing for Federal Express.

different delivery options or are limited to delivery options whose pricing is independent of the destination. On the other hand, the claimed invention is configured handle delivery options whose pricing varies as a function of the destination. Stated another way, the claimed machine could be used for delivery options the same or similar to those illustrated in the aforementioned Federal Express delivery options. Thus, it is respectfully submitted that neither the Pusic or Hsieh patents, either alone or in combination, disclose or suggest an automated mailing machine which provides for at least two selectable delivery options and includes a processor configured to compute the mailing cost as a function of three variables, namely; weight, delivery option and also destination.

Element (a) of Claim 77 also recites a display for displaying at least two selectable delivery options. None of the cited references discloses a display configured to display at least two selectable delivery options. As mentioned above, the Pusic patent does not disclose selectable delivery options. The Hsieh patent discloses a display but is not configured to display selectable delivery options. (See the Hsieh patent, Col. 3, line 68 to Col. 4, line 4 : "The weight of the letter will be shown on the display screen 19. The customer may then choose the type of mailing service which sort of mailing type he/she desires by depressing one of the letter-sorting keys 22."). It is also respectfully submitted that this element is not disclosed or suggested by any of the references of record.

With respect to the rejection of Claim 79, the Taleno patent was cited for disclosing a touch screen. The Taleno patent does not otherwise disclose the missing elements discussed above.

Based on the above, it is respectfully submitted that the Examiner has failed to make out a *prima facie* case of obviousness for failure to cite references which disclose all of the elements of the claims at issue, contrary to the criteria set forth in the MPEP § 2143.

**THE EXAMINER HAS FAILED TO SHOW A REASONABLE EXPECTATION OF SUCCESS**

Given the fact that none of the references disclose a machine that includes a processor configured to compute the mailing cost of a parcel based upon the weight of the parcel;

delivery option of the parcel and the destination of the parcel, it is respectfully submitted that there can be no reasonable expectation of success.

**THE EXAMINER HAS FAILED TO SHOW A SUGGESTION  
TO COMBINE THE REFERENCES**

In paragraph 15 of the Detailed Action mailed on February 3, 2006, the Examiner argues that the filing dates of the references are two years prior to the priority date of the instant invention. "thus establishing knowledge of the invention." MPEP §2143 requires that "*there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference, or to combine reference teachings.*" If anything, it should be clear that there was absolutely no "knowledge", to provide a system for processing delivery options whose pricing is dependent upon destination. As such, it is respectfully submitted that, it can hardly be said that any suggestion or motivation to combine various features was gained from the "knowledge" in the cited references. In addition, it is respectfully submitted that knowledge alone is insufficient to show motivation. As set forth by the Court of Appeals for the Federal Circuit in *Teleflex v. KSR International Co.*, 119 Fed. Appx. 282 (Fed. Cir. 2005)<sup>2</sup> "...the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." Knowledge alone is insufficient to satisfy the requirement that the Examiner must still provide a showing of a motivation to make the claimed combination ("...the test of whether it would have been obvious to select specific teachings must still be met by identification of some suggestion, teaching, or suggestion in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention. *In re Scon Johnston*, 2006 US App. Lexis 2282 (Fed. Cir. 2006).<sup>3</sup> Based on the above, it is respectfully submitted that the Examiner has failed to show a suggestion to make the combination suggested as required by MPEP §2143.

For all of the above reasons, it is respectfully submitted that the Examiner has failed to set forth a *prima facie* case of obviousness.

---

<sup>2</sup> Copy attached for the convenience of the Board.

<sup>3</sup> Copy attached for the convenience of the Board.

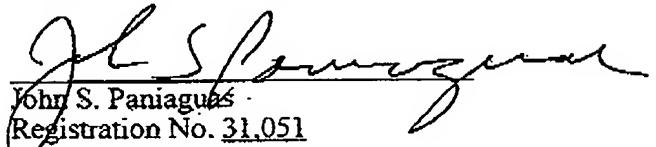
If The Examiner's rejection of Claim 79 under 35 U.S.C. § 103(a) as being Unpatentable over the Hsieh, Pusic and Tateno Patents

Claim 79 was rejected as being unpatentable under 35 USC § 103(a) as being unpatentable over the Hsieh and Pusic patents, as discussed above and further in view of the Tateno patents. Claim 79 is dependent upon Claim 77 and adds a limitation that the input system includes a touch screen. The Hsieh and Pusic patents were discussed above. The Tateno patent does not otherwise disclose a system for computing a mailing cost based upon: the weight of the parcel; a selected delivery option and a destination. For these reasons and the reasons above, it is respectfully submitted that the Examiner has failed to set forth a *prima facie* case of obviousness as required by MPEP §2143.

Conclusion

It is respectfully submitted that the Examiner's rejection fails to meet all three criteria set forth in § 2143 of the MPEP. First, the Examiner has failed to show any suggestion or motivation to combine the references in the manner stated. The Examiner simply opines the combination would be obvious. Second, without using the claims as a blueprint, the Examiner has failed to show a reasonable expectation or any expectation of the success of the proposed combination considering the fact that the proposed combination does not disclose all of the elements of the claims. The Board is respectfully requested to reverse the rejections of all claims by the Examiner.

Respectfully Submitted,

  
John S. Paniagua  
Registration No. 31,051

Date: 2/12/07

KATTEN MUCHIN ROSENMAN LLP  
1025 Thomas Jefferson Street, N.W.  
East Lobby, Suite 700  
Washington, DC 20007-5201  
Phone No. (312) 902-5200  
Fax No. (312) 902-1061

APPENDIX A  
CLAIMS ON APPEAL

Claim 77. An automated shipping machine for use in mailing a parcel or envelope comprising:  
means for receiving payment from a customer;

a scale for weighing said parcel or envelope to be mailed and determining a parcel or envelope weight;

a display for displaying at least two selectable delivery options and a cost for said selected delivery option and a cost for a selected delivery option;

an input system for receiving information representative of a destination for said parcel or envelope to be mailed and an indication of the delivery option selected by the customer, said delivery option selectable from at least two delivery options;

a processor system in communication with said input system and said scale for receiving said information representative of the destination, the selected delivery option and the weight of said parcel or envelope and computing a cost for mailing said parcel or envelope to said destination as a function of said weight and the selected delivery option;

printer means in communication with said processor for printing a bar code label for placement on the parcel or envelope to be mailed by the customer identifying at least said destination representative information and to print a shipping receipt for an amount including at least the cost of delivering said parcel or envelope to said destination via the delivery option chosen by said customer.

Claim 79. The automated shipping machine as recited in claim 77, wherein said input system includes a touch screen CRT.

Claim 80. The automated shipping machine as recited in claim 77, wherein said payment receiving means includes a credit card reader.

02-12-07 12:03

From-KATTEN MUCHIN ROSENMAN 13129021061

3129021061

T-406 P.19/20 F-197

**Attorney Docket No. 331235-00021**

**APPENDIX B**  
**EVIDENCE APPENDIX**

None

02-12-07 12:04

From-KATTEN MUCHIN ROSENMAN 13129021061

3129021061

T-406 P.20/20 F-197

Attorney Docket No. 331235-00021

**APPENDIX C**  
**RELATED PROCEEDINGS APPENDIX**

None